

REMARKS

This is a response to office action dated April 19, 2006. Claims 1-7, 9-26, and 33-78 are currently pending. Claims 73 to 78 are newly added and Applicants submit that these claims do not include non-elected subject matter or new matter.

The numbered paragraphs below correspond to the Examiner's numbered paragraphs:

1./2. The restriction requirement is acknowledged, but traversed. Applicants maintain that the Examiner has not provided any showing of an unreasonable burden in examination of the various species. MPEP 803 specifically indicates that "if the search and examination of all the claims in an application can be made without serious burden, the examiner MUST examine them on the merits even though they include claims to independent or distinct species."

According to the Examiner, a serious burden is imposed when examining a claim directed to application of the composition simultaneously with the application of a gas and a claim directed to application of a gas after terminating the application of the composition. Moreover, the Examiner believes a serious burden is imposed when examining claims on the various direction of gas flow. Applicants do consider these to be independent and distinct species but fail to see how a serious burden could possibly be imposed. In the next correspondence, Applicants respectfully request a reasonable explanation on how a serious burden is imposed on the Examiner by the unreasonable number of restriction requirements provided.

3. The Examiner has neglected to include the status of claims 71 and 72 in the office action summary. These claims appear to be rejected in paragraphs 6 and 8. Accordingly, Applicants assume that the failure to include these claims in the office action summary was a mere oversight by the Examiner.

4./5. Applicants thank the Examiner for the removal of the spurious 35 U.S.C. § 112 rejection.

6. Claims 1-6, 11, 13, 17-19, 21-24, 33-36, 44, 46, 48-54, 57-60, 71 and 72 remain rejected under 35 U.S.C. § 102(e) as being anticipated by Castro et al. (US 6,395,326). Although Castro fails to teach blowing of gas, the Examiner has contended that “one of ordinary skill in the art, upon reading Castro, would immediately envision the use of heated gas.”

Applicants respectfully traverse again and submit the following:

(a) The test for anticipation is not whether “one of ordinary skill in the art would envision the missing claimed element” as professed by the Examiner. A claimed element is either present or is not present. If it is not present, the anticipation rejection fails unless the claimed element is inherently present. With respect to the doctrine of inherency, the courts have made is very clear that inherency **cannot be based on a possibility or probability but must be necessarily present.** *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). The Applicants provided other very logical possibilities with respect to the heating element of Castro which the Examiner subjectively rejected as unreasonable possibilities. **The Examiner has blatantly rejected the holding of the Federal Circuit and has created her own new tenet stating, in essence, inherency cannot be avoided if other possibilities are shown so long as the Examiner decides that one of the possibilities is more reasonable than the other.** The Examiner has rejected the ruling of *In re Robinson* based on the fact that the Examiner finds her version of the possibility more plausible than the Applicants’ version of the many other possibilities. **Applicants respectfully submit that the Examiner’s basis for the rejection is flawed as the Federal Circuit has not provided a standard that if other possibilities exist, the examiner must chose what he or she thinks is the more reasonable possibility.** The Examiner’s newly created legal standard for inherency -- namely, “whether one of ordinary skill

in the art would envision the missing claimed element,” is devoid of any legal precedent and contrary to what has been established by the Federal Circuit in *In re Robinson*. Applicants reserve the right to raise this issue on appeal.

Moreover, Applicants respectfully submit that the Examiner’s counter argument of the facts is as specious and unfounded as the Examiner’s creation of her new legal standard for inherency. For example, the Examiner is reasoning that the conduit of Castro could not possibly be for housing electrical wires, but rather has to be for conveying heat from a control system to the nozzles. Applicants respectfully submit, what exactly does the Examiner base this bias on? Electrical wires typically are run through conduits, such as those in the Examiner’s own residence. Moreover, there is absolutely nothing in Castro to suggest that the “control system” is a gas blower.

(b) Regardless of the above arguments, enclosed are declarations from Daniel Castro, Syed Hossainy and Li Chin. As one of ordinary skilled in the art and as inventors of U.S. Patent 6,395,326, each is declaring that U.S. Patent No. 6,395,326 does not teach what is claimed in the independent claims. Applicants respectfully submit that these declarations should be sufficient to remove the Examiner’s conjured and fallacious version of Castro’s teachings.

7. Claims 9, 10, 15, 16, 20, 25-26, 41, 45, 55, and 56 remain rejected under 35 U.S.C. § 103(a) as being unpatentable over Castro. Based on the arguments above, removal of the rejection is respectfully requested.

8. Claim 1-6, 9-11, 13, 15-26, 33-36, 44-46, 48, 49, 51-58, 60, 70 and 71 remain rejected under 35 U.S.C. § 103(a) as being unpatentable over Ding et al. (US 6,358,556) in view of You et al. (US 6,407,009). The Examiner’s position, simply put, is that Ding teaches coating of a stent. Ding fails to teach directing a gas onto the stent. You teaches directing a gas onto a flat, 8

inch semiconductor wafer to improve coating conformity. Although the references provide no motivation to combine, according to the Examiner, the motivation can come from one having ordinary skill in the art to look to You to ensure coating conformity for the Ding stent.

Applicants respectfully traverse and provide the following arguments:

1. Applicants maintain the position that there is no motivation to combine. On page 7 of the office action, as correctly indicated by the Examiner, Ding “enables a thin layer of coating material to adherently conform to and cover the entire surface of the filaments of the open structure of the stent but in a manner such that the open lattice nature of the structure of the braided or other pattern is preserved in the coated device.” (emphasis provided by the Examiner) The Examiner is referring to col. 3, lines 53-58 of Ding which states “[t]he coating process enables the material to adherently conform to and cover the entire surface of the filaments of the open structure of the stent but in manner such that the open lattice nature of the structure of the braid or other pattern is preserved in the coated device.”

Simply put, Ding teaches that they have “enabled” a method that results in coating conformity while preventing any coating substance to cover the gaps between the stent filaments. In other words, this language teaches that the method enabled by Ding provides for a coating that does not suffer from non-coating conformity drawbacks. Yet, according to the Examiner, one reading Ding would be motivated to look at a semiconductor reference, which is outside the field of the Applicants’ endeavor, to correct coating conformity in Ding even though Ding has enabled a method that does not need any correction of the coating conformity. Applicants respectfully submit that this logic is counterintuitive as one of ordinary skill in the art reading Ding would not be motivated to resort to a semiconductor reference -- a reference which is far from the field of the medical device endeavor -- to cure a problem that Ding specifically states does not exist. In sum, one of ordinary skill in the art

would not be motivated to fix coating conformity where the reference teaches that it has enabled a method that result in excellent coating conformity.

2. Applicants respectfully submit that the references clearly teach away from each other.

It is improper to combine references where the reference teaches away from their combination.” *In re Grasselli*, 713 F.2d. 731, 743, 218 USPQQ 769, 779 (Fed. Cir. 1983).

As indicated by the Examiner in page 7 of the office action, the object of Ding is to **preserve the open lattice structure from the coating material**. In other words, Ding teaches that the **gaps of the substrate must not be filled with a coating substance**. In contrast, You teaches that it is an “object of the invention” to manufacture “spin-on layers with **better gap filling properties**.” (col. 3, lines 1 and 2) You specifically requires the gaps of the substrate to be filled. This is accomplished by inhibiting the evaporation of the solvent such that the viscous precursor material fills the gaps of the You substrate. The evaporation of the solvent can be accomplished by adiabatically cooling the chamber, application of a cooled biased gas, and cooling of the wafer.

In sum, Ding teaches a method of preventing the gaps of the substrate from being filled while You is specifically direct to the modification of its coating parameters to reduce the evaporation rate of the solvent such that the gaps in the substrate are filled. This is a classic case of two references teaching away from one another.

3. Ding and You, alone or in combination fail to teach all of the claimed elements. The Examiner has cited Ding for the application of the coating composition to a stent and You for directing a gas onto the stent. Applicants agree that You teaches application of a gas into the semiconductor chamber; however, You only teaches the application of a cooled gas to inhibit evaporation of the solvent, regardless of the vapor pressure of the solvent used.

With respect to claim 1, You fails to teach the **adjustment of the gas temperature based on the vapor pressure of the solvent**. In fact, You is solely concerned with cooling effects for retarding the evaporation of solvents. The teaching of the application of a cooled gas is not the same as adjusting the gas temperature based on the vapor pressure of the solvent.

With respect to elected species of claim 3, the references alone or in combination fail to teach simultaneous application of the coating substance and the gas. In fact, You specifically teaches and the precursor is applied **before** the application of the gas.

With respect to claim 23, again, You fails to teach adjusting the gas temperature based on the volatility of the solvent. Again, You only teaches application of cold gas and nothing based on the adjustment based on the volatility of the solvent used.

With respect to claim 26, Applicants fail to see how either of the references cited is even remotely relevant to this claim.

With respect to new claim 73, You fails “to induce evaporation of the solvent from the composition on the stent.” You is directed to the **opposite** effect: inhibition of evaporation of the solvent.

Accordingly, claims 1, 23, 54 and 73 are allowable. Their dependent claims are also allowable by at lease the virtue of their dependency. **Applicants also traverse the rejections of the dependent claims as being without merit and preserve the right to challenge all of the Examiner’s rejection on appeal.**


Since the generic claims 1, 23, 54 and 73 are allowable, Applicants respectfully request rejoinder of the non-elected species.

CONCLUSION

Applicants respectfully request withdrawal of all the rejections and allowance of the claims. Applicants respectfully request issuance of the notice of allowance. If the Examiner has any questions or concerns, the Examiner is invited to telephone the undersigned attorney at (415) 954-0345.

Date: October 13, 2006
Squire, Sanders & Dempsey L.L.P.
One Maritime Plaza, Suite 300
San Francisco, CA 94111
Telephone (415) 954-0345
Facsimile (415) 393-9887

Respectfully submitted,



Angie Augustus
Attorney for Applicants
Reg. No. 51,421